

### **REMARKS**

This amendment is in response to a first Office action (Paper No. 5) mailed 2 April 2003. Upon entry of this amendment, claims 1-9, 15, 16, 21-39, and 41-51 will be pending in this application.

The examiner stated in the Office action that claims 4 and 9 appear to contain allowable subject matter.

Claims 10-14, 17-20 and 40 have been cancelled without prejudice or disclaimer of its (their) subject matter. Claims 1-9, 15, 16, 21, 24, 31, 33 and 34 have been amended. Applicants have newly added claims 41 to 51 by this amendment.

Petition to Make Special under 37 CFR §1.102 is concurrently submitted herewith.

#### **I. Claim objection**

Claim 33 was objected to because of the informality

The term “estending” has been corrected to “extending.”

Claims 1-2, 6-7, 11, 13, 15, 21, 24, 31 and 34 are objected to because of the term “CS T@.”

The term “CS T@” has been corrected to “cSt.”

#### **II. Claim rejection - 35 U.S.C. 112**

Claims 1-40 are rejected under 35 U.S.C.112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The viscosities and the temperatures in claims have been amended to only recite centistokes unit and centigrade units. Withdrawal of the rejection is respectfully requested.

2. The examiner asserted that the phrase “further comprised of” is indefinite and confusing in each of claims 2-5, 7-10, 12, 14, 30 and 40 and may overcome with the use of the phrase “wherein.”

The applicant respectfully traverses the examiner’s rejection.

There is no support in either the statute, case law or the MPEP for the examiner’s assertion.

The first sentence of the second paragraph of 35 U.S.C. 112 requires only that claims “set out and circumscribe a particular area with a reasonable degree of precision and particularity.” In re Miller, 442 F.2d 689, 692 (CCPA 1971), *quoting In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. (Amgen Inc. v. Chugai Pharmaceutical Co. Ltd., 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991), *cert. denied*, 112 S.Ct. 169 (1991)).

Furthermore, definiteness of claim language must be analyzed, not in a vacuum, but in light of (1) the content of the particular application disclosure, (2) the teachings of the prior art, and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. (In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed.

Cir. 1983); Rosemount, Inc. V. Beckman Instruments, Inc., 727 F.2d 1540, 221 USPQ 1 (Fed. Cir. 1984); W.L. Gore & Assos., Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)).

The phrase “further comprised of” is widely used in the patent claims. The phrase does not make the claims indefinite. The claims having “further comprised of” reasonably apprise those of skill in the art of its scope. Therefore, the claims having “further comprised of” are not indefinite. Also, there is no requirement of using “wherein” under the U.S. Patent Law and rules. (MPEP §2173.02 states that “[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.” (Emphasis added))

Written withdrawal of the rejection is respectfully requested.

3. The examiner asserted that claims 5, 10, 12, 14, 16, 18 and 20 appear to duplicate one another and therefore are indefinite.

Claims 10, 12, 14, 18 and 20 have been cancelled.

Remaining claims 5 and 16 are not duplicate one another.

Claim 5 depends from the independent claim 1. Claim 1 has the transitional term “comprising.” Claim 16 depends from the independent claim 6, which has the transitional phrase “consisting essentially of.”

Therefore, even if the claimed contents of the hydrocarbon oil and the copolymer are the

same, the claims have the different scope owing to the transitional term.

Withdrawal of the rejection is respectfully requested.

4. The examiner asserted that claims 6, 13, 15 and 17 are indefinite in that they appear to duplicate one another and all the claims except for one should be cancelled.

Claims 13 and 17 have been cancelled. Claims 6 and 15 are not the same. Unlike claim 15, claim 6 uses the transitional term “comprising.”

Withdrawal of the rejection is respectfully requested.

5. The examiner asserted that the term “compound” is indefinite in that it appears that a composition is being used.

The term “compound” has been changed to the term “composition.”

### **III. Claim rejection - 35 U.S.C. 102**

Claims 1-3, 6-8, 11, 13, 15, 17, 19, 21, 23-24, 31 and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Morrison et al. (U.S. Patent No. 5,879,694).

In Verdegaal Bros., the Court held that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros v. Union Oil Co. of California, 814 F.2d 628 (Fed. Cir. 1987).

**First**, Morrison et al. ‘694 does not disclose the free standing compound.

Generally, the preamble does not limit the scope of the claims. However, when the preamble breathes life and meaning into the claim, it limits the scope of the claims. For example, in Union Oil Co. of California, the court held that the preamble, “An unleaded gasoline fuel suitable for combustion in an automotive engine” limits the scope of the claim and the prior art for aviation fuels does not anticipate the ’393 patent because aviation fuels are different from motor fuels. Union Oil Co. of California v. Atlantic Rechfield Co., 208 F.3d 989, 54 USPQ2d 1227 (Fed. Cir. 2000), *cert denied*, 121 S.Ct. 1167 (2001).

Here, the claims in the present application include the limitation of “free standing” in the preamble. Like Union Oil Co., this phrase in the preamble limits the scope of the claim because “free standing composition” is different from “non-free standing composition.”

**Second**, more importantly, Morrison et al. ’694 does not disclose the limitations of the viscosity of the hydrocarbon oil and flash point of the hydrocarbon oil.

Morrison et al. ’694 does not disclose the free standing candle. All of the examples and the specification are only directed to jar candles. Moreover, Morrison et al. ’694 neither recognizes, defines nor optimizes either the viscosity or the flash point of the hydrocarbon oil for free standing candles.

The fact that the applicant alone, and not Morrison et al. ’694, invented the transparent and free standing composition for the candles is convincing evidence of a lack of anticipation. The claimed ranges are critical for the transparent and free standing properties. (The examiner’s attention is further invited to consider the applicant’s specification, where the applicant wrote that: “Two of

these values [(i.e., viscosity and flash point)] for the hydrocarbon oil of TABLE 1 are very important when choosing the hydrocarbon oil” at paragraph 43. In the specification, the applicant defines the phrase “free standing” as the compound “having the ability to stand by itself at room temperature, such that even during use of a candle made with the compound, such that the heat of the candlewick’s combustion does not melt nor deform the body of the candle made with the compound of the present invention.” (Page 2, lines 8 to 12; emphasis added) That is, the term “free standing” should be distinguished from the ordinary meaning of the term “hard” or “stiff” at room temperature.

Therefore, the examiner’s anticipation rejection should be withdrawn because the examiner fails to show the viscosity limitations and the flash point limitation in Morrison et al. ‘694.

#### **IV. Claim rejection - 35 U.S.C. 103**

Claims 5, 10, 12, 14, 16, 18, 20, 22, 25-30, 32 and 34-40 are rejected under 35 U.S.C.103(a) as being unpatentable over Morrison et al. 5,879,694 and 6,066,329 (Morrison patents) .

Independent claims 1, 6, 15, 21 and 31 are not obvious over Morrison et al. 5,879,694 and/or 6,066,329 for the following reasons. Thus, all of their dependent claims are not obvious.

The examiner fails to establish a prima facie case of obviousness because the viscosity and the flash point limitations is not taught or suggested in the prior art.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981 (CCPA 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re

Wilson, 424 F.2d 1382, 1385 (CCPA 1970).

In In re Wertheim, the court held that in the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. The court set out “exceptions to this rule in cases where the results of optimizing a variable, **which was known to be result effective**, were unexpectedly good.” (In re Antonie, 195 USPQ 6, 8 (CCPA 1977), In re Waymouth, 182 USPQ 290 (CCPA 1974)). Thus, it should be noted that, in In re Antonie, the court held that **a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.** (559 F.2d 618, 195 USPQ 6 (CCPA 1977)). (In In re Antonie, the claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result- effective variable. See also MPEP 2144.05 II. B.) It should be also noted that the court has consistently refused to recognize “obvious to try” rejections. (“[O]bvious to try is not the standard of 35 U.S.C. §103.”, In re Tomlinson, 53 CCPA 1421, 363 F.2d 928, 150 USPQ 623 (CCPA 1966)).

In accordance with the above the rules, if a particular parameter is not first recognized as a result-effective variable which achieves a recognized result, a prima facie case of obviousness does not exist.

Here, the Examiner fails to establish a prima facie case for at least one of the following reasons.

**First**, as stated above, the claim limitations of the viscosity and the flash point are not taught nor suggested by the prior art. Since the Morrison patents are directed only to jar candles, there is no suggestion or motivation to modify the Morrison patents separately or in combination.

Since the examiner did not show that the claimed ranges of the viscosity and the flash point overlap or lie inside ranges disclosed by the prior art, the examiner failed to show a prima facie case of obviousness.

**Second**, the viscosity and/or the flash point are not recognized as result effective variables in the prior art.

The description and the claims describe the viscosity range of the hydrocarbon oil for the free standing compound” and the flash point for allowing the correct combustion of the free standing compound or candle. The applicant clearly stated in the specification that the limitations of the viscosity and the flash point are critical to the present invention. (Page 13, lines 2-5)

Morrison did not recognize the viscosity of the hydrocarbon oil or the flash point of the hydrocarbon oil as a result effective variable to the “free standing” compound.” It should be also noted that the court has consistently refused to recognize “obvious to try” rejections.

Therefore, independent claims are patentable, and thus their dependent claims are also patentable.

**Third**, with respect to claims 27 and 37, “air bubbles” are not disclosed in Morrison 5,879,694 and/or 6,066,329.



Morrison patents disclose only decorative elements made by adding decorative additives such as colorants, decorative materials, fragrances, or functional additives. The air bubbles in claims 27 and 37 are different from these decorative additives. These bubbles are made in the process of manufacturing candles by controlling the temperature of the mixture. The examiner merely asserted that the teachings of the decorative additives render obvious the element of the "air bubbles. Since the Morrison patents only shows how to make the decorative additives, not how to make the air bubbles, the examiner's assertion is based on the improper hindsight reasoning. In other words, it would not have been obvious to the ordinary skilled person in the art to include air bubbles in the candles from the teaching of the Morrison patents.

Withdrawal of the rejection is respectfully requested.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

A fee of \$9.00 is incurred by the addition of one(1) total claims in excess of total 40 for ***Small Entity***. Applicant's check drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Should a Petition for extension of time be required with the filing of this Amendment, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if a check of the requisite amount is not enclosed.

Respectfully submitted,



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